

Beiersdorf 730-WCG
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g/m² to 3000 g/m².

Claim 18 (previously added)

18. The method of claim 1, wherein said coating is applied at a weight per unit area of from 100 g/m² to 2,000 g/m².

Claim 19 (previously added)

19. The method as claimed in claim 1, wherein the substance at the processing shear has a dynamic zero temperature viscosity of from 1 Pa.s to 500 Pa.s.

REMARKS

Status of Claims

Claim 3 was amended in the previous response but the mark-up showing the change was inadvertently omitted. The claim amendment has been repeated above with the appropriate mark-up.

35 U.S.C. 103(a) rejections

Claims 1 and 3-19 were rejected as being obvious over Ludwig (U.S. Patent 5,122,219) in view of: Moriarity (U.S. Patent 6,273,701). The applicants request reconsideration of this rejection for the following reasons:

- (1) Even if the references could be combined, they still do not teach every element of the applicants' claimed invention;
- (2) Even if a reference could be found which possesses the missing element of the primary reference (Ludwig), the nature of Ludwig's invention teaches away from making the modification suggested.
- (3) There is no factual basis for the assertions made by the examiner.
- (4) The preponderance of the evidence suggests that the claims are not obvious.

(1) Every element of applicants' claim not accounted for by either reference

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

Even if it were permissible to combine Ludwig with Moriarity, the combination of references still

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lacks the feature of the applicants claim where "...the die body is bent transversely to the direction of travel of the backing material and the bending is induced by temperature differences within the die body." (see last two lines of applicants' claim 1).

(2) Ludwig teaches away from bending the die body

MPEP 2143.01 states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." Paraphrasing part of the arguments first presented in the response of 16 January 2003, if Ludwig's die were bent in any way, the planar surface would not be uniform and as such Ludwig would not produce their desired uniform coating, i.e. Ludwig's principle of operation would be changed.

(3) No factual basis for "it would have been obvious..." assertions

Obviousness is a legal conclusion based on factual inquiries. Even if there were no basis for making arguments (1) and (2) above, there is no factual basis for the numerous "it would have been obvious..." assertions made by the examiner which included:

- (1) to modify Ludwig to provide a thermal adjustment system
- (2) that the coating fluid provides part of the temperature control of the various zones
- (3) to move the die in its mounts
- (4) that the bending would be controlled proportionate to the amount of the substance applied
- (5) to apply hot-melt pressure sensitive adhesive
- (6) optimize the amounts of material applied passed on the final product.

MPEP 2143 states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" and MPEP 2143.01 establishes that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)".

The combination of the prior art references when given a reading most favorable to the examiner's position represents a mere collection of elements with no instruction as to how to put the

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invention together to arrive at the applicants' invention. There does not appear to be any factual basis to state that the prior art teaches all of the reasons modifications suggested by the examiner. As stated in MPEP 2142, "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."

At best, the modifications suggested appear to be a suggestion of an obvious to try rationale. MPEP 2144.05 X. states that "[t]he admonition that 'obvious to try' is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." In the present case, the former kind of error would appear to apply.

(4) Preponderance of the Evidence

In light of the lack of evidence support making the appropriate modifications as presented in arguments (1)-(3) made above, the preponderance of evidence suggests that the applicants' invention is unobvious over the prior art. See MPEP 2142:

"...The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it.

With regard to the rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e. the reference teachings establish a *prima facie* case of obviousness) is more probable than not."

For these reasons, it is believed that the examiner would be justified in rescinding the rejection based on Ludwig in view of Moriarity.

Claims 1, 3-7 and 9-19 were rejected as being obvious over EP 622 127 A1 ("127") in view of Moriarity, (U.S. Patent 6,273,701). The applicants request reconsideration of this rejection for essentially the same reasons offered above in relation to Ludwig in view of Moriarity.

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6713-Hn/be**Prosecution Notes**

As this application is in after final status, if there is an amendment which may place the application in condition for allowance, it is requested that this be indicated on the Advisory Action. In light of the latest *Festo* decision (relating to Doctrine of Equivalents) and the costs associated with appeal, it will be very difficult for the applicants to retreat from their position after submission of an Appeal Brief.

As an illustration of why this is so, selected passages from the recent *en banc* decision by the CAFC on *Festo* (26 September 2003) are provided below:

"...we reinstate those holdings of *Festo V* that were not disturbed by the Supreme Court. To begin with, we recognize that the Court expressly endorsed our [Federal Circuit's] holding that a ***narrowing amendment*** made to comply with any provision of the Patent Act, ***including §112, may invoke an estoppel....When the prosecution history reveals no reason for the narrowing amendment, Warner-Jenkinson presumes that the patentee had a substantial reason relating to patentability;*** consequently, the patentee must show that the reason for the amendment was not one relating to patentability if it is to rebut that presumption...In this regard, we reinstate our earlier holding that a patentee's rebuttal of the *Warner-Jenkinson* ***presumption is restricted to the evidence in the prosecution record.***" see *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.* (downloadable at <http://www.fedcir.gov/opinions/95-1066c.doc>).

Closing

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700